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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,692	02/04/2004	Bruce C. Polzin	080643-0111	5118
7590	06/06/2006			EXAMINER KYLE, MICHAEL J
James A. Wilke Foley & Lardner Suite 3800 777 East Wisconsin Avenue Milwaukee, WI 53202-5306			ART UNIT 3677	PAPER NUMBER

DATE MAILED: 06/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application N .	Applicant(s)	
	10/772,692	POLZIN ET AL.	
	Examiner Michael J. Kyle	Art Unit 3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 14 March 2006.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-11 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1.. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rechelbacher (U.S. Patent No. 6,647,582) in view of Kendall (U.S. Patent No. 5,775,233). With respect to claims 1 and 2, Rechelbacher discloses a cushioning and vibration dampening apparatus comprising an overmold (30). The overmold is a mixture of an elastomeric material (38, 46) and a gel or putty like substance (32). The overmold comprises first (46) and second (38) non-foam layers enveloping a gel or putty like layer. Rechelbacher discloses the elastomeric material to be rubber or plastic. The first and second non-foam layers envelop the gel or putty layer as a unitary, separable overmold. Examiner considers this to be thermoplastic rubber. Rechelbacher discloses the layer enveloped by the non-foam layers to be a gel or putty like material, but does not specifically disclose foam.

3. Kendall teaches a handle grip (11) comprising either gel or foam, or equivalents thereof (column 4, lines 4, 5). Thus, Kendall shows gel and foam to be equivalent as either may be used to accomplish the same function. Foam includes micro-cellular foams. It would have been obvious to one having ordinary skill in the art at the time of the invention to make the middle layer from either gel or foam, as they are equivalent within the art.

4. Claim 3 recites method limitations (“integrally molded” and “injection molding”) in an article or apparatus claim. This method limitation is given little patentable weight.

Rechelbacher and Kendall’s non-foam layers and the foam layer can be integrally molded with each other. Examiner notes that in a product-by-process claim such as these claims, the prior art must only be capable of being made by the claimed process, as long the as the final product meets the structural limitations of the claim. See MPEP 2113.

5. With respect to claim 4, Rechelbacher discloses a substrate member (18) coupled to the overmold member (30).

6. With respect to claims 5 and 6, the combination of Rechelbacher and Kendall disclose the non-foam layers and foam layer can be mechanically attached (via 42 and 44 of Rechelbacher) or bonded to the substrate member. Examiner considers the grip of Rechelbacher to be bonded to the substrate because it is fixedly attached to the substrate.

7. With respect to claim 7, Rechelbacher discloses the substrate member to be wood.

8. With respect to claims 8 and 10, the combination of Rechelbacher and Kendall fails to disclose the thickness of the foam layer to exceed the combined thickness of the non-foam layers, or for the thickness to be equal. However, such a modification does not appear to bring about a new or unexpected result. One having ordinary skill in the art would recognize that changing the relative thickness of the foam and non-foam layers on a known structure will affect the flexibility of the overmold member, but will still provide the cushioning and vibration dampening functions. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the combination of Rechelbacher and Kendall such that the

thickness of the foam layer is equal to or exceeds the combined thickness of the non-foam layers, as such a modification does not produce a new or unexpected result.

9. With respect to claim 9, the combination of Rechelbacher and Kendall discloses the thickness of the non-foam layer to exceed the thickness of the foam layer (figure 5 of Rechelbacher).

10. With respect to claim 11, Rechelbacher discloses the overmold to be configured in a predetermined shape.

11. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rechelbacher in view of Kendall as applied to claim 1 above, and further in view of Watarai (U.S. Patent No. 5,848,555). Rechelbacher discloses the elastomeric material to be rubber or plastic. While examiner considers the rubber of Rechelbacher to be a thermoplastic rubber as claimed, examiner further relies on the teachings of Watarai to further show equivalents between rubber and the claimed materials.

12. Watarai teaches a grip portion (4) made from rubber or polyvinyl chloride ("PVC", column 1, line 66). Thus, these two materials are equivalent and interchangeable within the art, as either material may be used to accomplish the same function. It would have been obvious to one having ordinary skill in the art at the time of the invention to make the elastomeric material of either rubber or PVC, as these materials are equivalent in the art.

*Response to Arguments*

13. Applicant's arguments filed March 14, 2006 have been fully considered but they are not persuasive. With respect to the amendment to claim 1, require a "unitary, separable overmold member", examiner notes that in Rechelbacher, there is a single, or unitary, overmold member (30).

***Conclusion***

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

15. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Kyle whose telephone number is 571-272-7057. The examiner can normally be reached on Monday - Friday, 8:30 am - 5:00 pm.

17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on 571-272-7075. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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**ROBERT J. SANDY**  
**PRIMARY EXAMINER**